



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,899	09/10/1999	MICHAEL F. BRAITBERG	4154-3	3485

32605 7590 07/20/2004

MACPHERSON KWOK CHEN & HEID LLP  
1762 TECHNOLOGY DRIVE, SUITE 226  
SAN JOSE, CA 95110

EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/393,899

Applicant(s)

BRAITBERG ET AL.

Examiner

Debra F. Charles

Art Unit

3628

*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003 and 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3628

The examiner is reversing the office action mailed August 26, 2003 to include a November 25, 2003 supplemental response from the attorney.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 11 July 2003 has been entered.

***Response to Amendment***

2. Claims 31 and 34 have been amended in the July 11, 2003 letter. Claim 31 has been further amended in the November 25, 2003.

***Claim Objections***

3. Claims 36 and 37 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A proper dependent claim shall not conceivably be infringed by anything that would not also infringe the base claim. See MPEP § 608.01(n), Section III. However, the pending claims 36 and 37 recite "the content" is being downloaded "to the optical disk over a communication link. One the other hand, the base claim number 31 recites that "each optical disk" distributed "to a plurality

Art Unit: 3628

of users" "includes the content and a unique identifier." Applying the infringement test, what is needed to infringe claim numbers 36 and 37 is a CD-ROM having a unique identifier without content. However, such a CD-ROM would not infringe the method steps of claim 31 since the CD-ROM does not include the content when it is distributed to a plurality of users. As a result, claims 36 and 37 are improper dependent claims.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 31,32,34 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 recites the limitation "the first permission code" in line 6, and in claim 32. There is insufficient antecedent basis for this limitation in the claim. Claim 34 recites the limitation "second payment" in line 1. There is no indication of a first payment in earlier numbered claims. Claim 38, line 1, "said first payment" does not have proper antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

Art Unit: 3628

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subler et al. (U.S. PAT. 5646992A) and Itami et al. (U.S. 6278984 B1).

Re claims 31 and 34: Subler et al. disclose a method for distribution of content, comprising:

distributing information content-mastered optical disks to a plurality of users, wherein each optical disk includes the content and a unique identifier, and wherein a first portion of the content on each optical disk is readable by an optical disk reader only in response to the following steps(Abstract, Fig. 1, col. 3, lines 15-35, col. 9, line 35-col. 10, line 40, CD-ROM is an optical disk):

generating a access code by using the permission code and the unique identifier (Fig. 4, 5, 9, col. 9, line 35-col. 10, line 40, i.e. "unique request number" and "unique item encryption key", and col. 16, lines 20-30, i.e. "hybrid scheme"), and

wherein the optical disk reader(Fig. 1) may read the portion of the content stored on the optical disk; writing the access code onto the optical disk, whereby the optical disk reader may read the first portion of the content stored on the optical disk by using the access code or reading portion of the content using second access code(col. 3, lines 1-35, i.e. "controlling access of items to be distributed"

Art Unit: 3628

and "arrange for users to have automatic access in later revisions to items that they paid for in earlier revisions" and the parallel of this is the distributor may charge a fee for subsequent access to items person paid for in earlier versions; and col. 4, line 15-40, i.e. "the valued items are stored on the CD-ROM in encrypted forma and are unusable by the end user until has paid for their use.")

Subler et al. does not explicitly disclose(s) first or second access code, first or second permission code, first or second portion or distributing a first permission code to the optical disk reader in exchange for a first payment. However, in Abstract, Fig. 3, 4, col. 2, lines 39-col. 3, line 20, col. 4, line 35-57, col. 5, lines 50-67 thereof, Itami et al. disclose(s) first and second ID, comparing the first and second ID, reading the first and second ID. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Subler et al. by adopting the teachings of Itami et al. The motivation to combine these references is building the first and second checkpoints as signified by the ID is an effective way to ensure only content paid for is available to the purchaser.

Re claims 32, 36, 37, 39 and 40: Subler et al. do not explicitly disclose(s) that distributing the first permission code comprises distributing the first permission code and first access code generated by a computer, which is remotely connected to the optical disk reader, via the internet. And the step of distributing information content-mastered optical disks comprises downloading the content to the optical disks over a communications link. However, in col. 16, lines 30-45,

Art Unit: 3628

Subler et al. disclose(s) computer network media which is an internet and a communications link. Thus, it would have been obvious to one of ordinary skill in the art to employ the internet to get the benefit of transmitting the content via the internet to speed transmission and keep distribution costs low.

Re claim 33: Subler et al. disclose the content includes content selected from among text content, music content, software and motion picture content(col. 3, lines 45-55, i.e. "not only for software, and databases, but for virtually any product").

Re claim 35: Subler et al. disclose the step of distributing information-content-mastered optical disks comprises unsolicited distributing of information content-mastered optical disks(col. 4, lines 15-35, col. 7, lines 44-55).

Re claim 38: Subler et al. disclose the first payment is a payment performed by authorizing a charge to a credit or debit account over a communications link(col. 15, lines 20-30, col. 16, line 10-40).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Van Hoff et al. (U.S. PAT. 5919247A) disclose distribution method and system for software applications.

Art Unit: 3628

Saito et al. (U.S. PAT. 5848158A) disclose a data copyright management system whereby the primary user edits a received data and supplies the edited data to a secondary user.

Collart (U.S. PAT. 6453420B1) disclose a system, method and apparatus for tracking the distribution of content electronically.

Dolphin (U.S.PAT. 5677953A) disclose supporting high density removable media to be used as distributed media.

Tozaki et al. (U.S. PAT. 5758008A) disclose a recording apparatus providing a first signal process unit for compressing video signal.

Yin (U.S. PAT. 6028620A) disclose forming machine readable code on an optical information storage disk.

Takatsuka (U.S. PAT. 5918165A) disclose a radio selective calling receiver having a predetermined message display function.

Kuwano (U.S. PAT. 6119132A) disclose an apparatus ID as an identifier of a filing apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles  
Examiner  
Art Unit 3628

\*\*\*



HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600